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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/232,488	01/15/1999	DONNA E. PRUNKARD	PPL-1REISSUE	1781

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EXAMINER

CROUCH, DEBORAH

ART UNIT	PAPER NUMBER
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1632

MAIL DATE	DELIVERY MODE
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08/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/232,488	PRUNKARD ET AL.	
	Examiner	Art Unit	
	Deborah Crouch	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-13,16,17,23-25 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13,16,17,23-25 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/24/99</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant's arguments filed March 3, 2009 have been fully considered but they are not persuasive. The declaration has been reviewed but is not proper for reasons set forth below. Claims 1,2,5-13,16,17,23-25 and 34 are pending.

The inventors of this reissue application are Donna E. Prunkard and Donald C. Foster.

Several issues have been found that prevent the allowance of this application.

1. Sequence Compliance. Please note that the sequence listing does not convey from the patent into the reissue.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a) (1) and (a) (2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth below.

A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 § CFR 1.821(e). A paper copy of the "Sequence Listing" also has not been received. Applicant must provide a CRF and paper copy of the "Sequence Listing" in response to this office action along with a statement that the paper listing and the CRF are the same and no new matter has been entered.

It is noticed that a proper CRF was filed in reissue parent patent 5639940. Applicant may request transfer of the CRF in '940 in lieu of providing a separate CRF for the present application. The transfer would be proper only if the Sequence Listings in the patent and those in this reissue application are the same. Below is a sample paragraph for requesting transfer of the CRF.

The paper or compact disc copy of the Sequence Listing in this application [application number], is identical to the computer readable copy of the Sequence Listing filed in application [application number], filed [date]. In accordance with 37 CFR 1.821(e), please use the [first-filed, last-filed or only, whichever is applicable] computer readable form filed in that application as the computer readable form for the instant application. It is understood that the Patent and Trademark Office will make the necessary change in application number and filing date for the instant application. A paper or compact disc copy of the Sequence Listing is [included in the originally-filed specification of the instant

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application, included in a separately filed preliminary amendment for incorporation into the specification, whichever is applicable].

2. Consent of assignees:

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal.

The consent of assignee is improper because if the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership. 37 CFR 3.73(b). Applicant is encouraged to use PTO form PTO/SB/96.

The consent of assignee filed January 15, 1999 in view of the reissue oath also filed on January 15, 1999 is confusing. The consent of assignee is signed by representatives of both ZymoGenetics, Inc and PPL. However, the individuals who assigned to PPL are no longer inventors of the claimed invention. The confusion arises because it is not clear if PPL remains an assignee. This issue maybe clarified by a proper consent of assignee along with a clarification in the response by the applicant as to who is now the assignee(s).

3. Claim amendments

Claims 12, 13, 16 and 17 are objected to as they do not comply with the requirement of 37 § CFR 1.173. Correction is required in response to this office action.

37 § CFR 1.173 states

(b)(2) *Claims*. An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(d) *Changes shown by markings*. Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or

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by an amendment paper in the reissue application, must include the following markings:

- (1) The matter to be omitted by reissue must be enclosed in brackets; and
- (2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)).

Amended claims filed August 6, 2007 contain omitted subject matter lined through. See claim 12. Further, the amended claims require identifiers. In response to this office action, applicant should file a revised set of claims in the proper format.

4. Oath

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

MPEP 1414.01

If additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration, a supplemental reissue oath/declaration must be filed, unless all additional errors corrected are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 U.S.C. 251 (see MPEP § 1402). In other words, a supplemental oath/declaration is required where any "error" under 35 U.S.C. 251 has been corrected and the error was not identified in the original reissue oath/declaration.

The supplemental reissue oath/declaration must state that every error which was corrected in the reissue application not covered by the prior oath(s)/declaration(s) submitted in the application arose without any deceptive intention on the part of the applicant.

An example of acceptable language is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

A supplemental reissue oath/declaration will not be effective for any errors which are corrected by a filing made after the execution of the supplemental reissue oath/declaration, unless it is clear from the record that the parties executing the document were aware of the nature of the correction when they executed the

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document. Further, a supplemental reissue oath/declaration with an early date of execution cannot be filed after a correction made later in time, to cover the correction made after the execution date. This is so, even if the supplemental reissue oath/declaration states that *all errors up to the filing of the supplemental reissue oath/declaration oath or declaration* arose without any deceptive intention on the part of the applicant.

Form PTO/SB/51S, "Supplemental Declaration For Reissue Patent Application To Correct 'Errors' Statement (37 CFR 1.175)," may be used to prepare a supplemental reissue declaration. Form PTO/SB/51S serves to indicate that every error in the patent that was corrected in the reissue application, but was not covered by a prior reissue oath/declaration submitted in the reissue application, arose without any deceptive intention on the part of the applicant.

In the event that the applicant for a reissue applicant is required to file a supplemental reissue oath/declaration that also includes a specific statement of the error being corrected by reissue in accordance with 37 CFR 1.175(c), as discussed in subsection I. below, applicant must also include in the supplemental declaration language equivalent to the "Every error ." language in the example of acceptable language set forth above. Therefore, if either form PTO/SB/51, "Reissue Application Declaration By The Inventor," or form PTO/SB/52, "Declaration By The Assignee" (see MPEP § 1414) is used for the purpose of filing such supplemental reissue oath/declaration, the form must be completed so that it is clear that the supplemental reissue oath/declaration addresses all errors corrected subsequent to the date upon which the last previously reissue oath/declaration (whether original or supplemental) was filed. For example, the form could be completed by specifying the date upon which the reissue application was originally filed, the reissue application number, and the date(s) of every amendment filed subsequent to the date upon which the last reissue oath/declaration (whether original or supplemental) was filed. Any manner of completing the form so that affiant/declarant unambiguously states that every error corrected subsequent to the filing of the last filed reissue oath/declaration (whether original or supplemental) arose without deceptive intent will be acceptable. It will not be acceptable for the new ("catch-up") oath/declaration to simply refer to the reissue application as filed, even though the new oath/declaration may be submitted after an amendment.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The oath filed January 9, 2009 is defective. Inventor Foster signed 2006 and inventor Prunkard signed December 10, 2008. However errors in the claims were corrected in the amendment filed August 6, 2007. See claim 12. None of these corrections were accompanied by a properly executed supplemental oath. Inventor Foster's signature cannot attest to the amendments made in the August 6, 2007 filing as his signature is a year and a half earlier. Therefore oath is defective as inventors Foster and Prunkard have not both signed an oath dated

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along with or after claim amendments. A new oath is required with both inventors signing on or after the claim amendment date. Applicant should consider using PTO/SB/51S for the supplementation declaration.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1,2,5-13,16,17,23-25 and 34 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above. Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. See MPEP § 1414.01.

5. Protest

All documents submitted with the protest under 37 § 37 § CFR 1,291, filed Mary 24, 1999, have been considered as indicated on the accompanying PTO-1449.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch, Ph.D. whose telephone number is 571-272-0727. The examiner can normally be reached on M-Fri, 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Crouch/
Primary Examiner, Art Unit 1632